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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :BUCHHOLZ, Herwig, et al

Serial No. : 10/667,653

Group Art Unit: 1617

Filed : 23 September 2003

Examiner: Young Soo Chong

For : PREPARATION HAVING ANTIOXIDANT PROPERTIES

RESPONSE TO REQUIREMENT FOR RESTRICTION

MAIL STOP AMENDMENT

Commissioner for Patents

Box 1450

Alexandria, Virginia 22313-1450

SIR:

In response to the Office Action mailed October 28, 2005, and the restriction requirement set forth therein, Applicants hereby elect Group I, claims 1-11 and 18, drawn to antioxidant compositions. The election is made with traverse for the reasons set forth below. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

Regarding Group II, the methods for preparing the compositions, it is alleged that the method is merely a mixing of the components together and that such mixing was, in general, well known in the art. This fact does not, however, support restriction of this group. This does not support either that (1) the process can be used to make other materially different products or (2) the product can be made by a materially different process. As to (1), the claimed process requires mixing of a component of claim 1. The known processes for mixing, e.g., paints, do not mix such a component as applicants' claim 1. Mixing of different components for making a materially different product is not using applicants' claimed process for such. Regarding (2),

there is no allegation of any materially different process for making applicants' compositions. It is further noted that claim 13 is more than merely mixing, i.e., it requires reactions for making the claim 1 compound. Thus, the reasoning in the Office Action does not address support for restricting this claim. Finally, it is urged that the search and examination of the methods for mixing the components to prepare the claimed compositions would not give rise to a serious additional burden of search; see MPEP §803. If the compositions, based in their broadest embodiment on a single component of formula I, are found novel and nonobvious, it would seem evident that the method for mixing the formula I component to obtain the composition or reacting methods for making the formula I component would necessarily also be novel and nonobvious. For the above reasons, it is urged that the restriction of Group II from Group I should be withdrawn.


Regarding Group III, the claims thereof are directed to a method of using the claimed compositions. The restriction is based on the allegation that the method of use can be practiced with a materially different product and the known use of selenium as an antioxidant is recited. Applicants respectfully submit, however, that the use of selenium as an antioxidant will not achieve the same effects as the method using applicants' compositions containing the compound of formula I. Given the completely different chemical structure and nature of applicants' formula I compound from selenium, there could be no expectation in the art that the method with selenium would be the same as applicants' method. Further, reference is made to MPEP §806.05(i) regarding the impropriety of restricting process of using claims where there is no proper restriction between the product and process of making claims. It is additionally noted that the process of using claims require the particulars of the composition claims – they are

dependent thereon. Thus, no serious burden of search is apparent, i.e., if the compositions are novel and nonobvious, the method requiring use of such particular composition must also be novel and nonobvious. For the above reasons, the restriction of Group III from Groups I and II should be withdrawn. At the least, it should be indicated that rejoinder is appropriate in this situation.

Favorable action is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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